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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/604,698

08/11/2003

Tang Foo Hou

SIC-03-014

1697

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10/18/2006

DELAND LAW OFFICE

P.O. BOX 69

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EXAMINER

WINDLEY III, WILLIAM R

ART UNIT

PAPER NUMBER

3682

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/604,698	HOU, TANG FOO	
	<b>Examiner</b>	<b>Art Unit</b>	
	William Windley III	3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tagawa USP 5315891.

Re claim 1 Tagawa discloses a bicycle shift control device comprising a base member (6) for attachment to the bicycle, an operating member (11) rotatably supported relative to the base member for rotating in first and second directions around an operating member axis (Column 4, lines 16-25); a transmission control member (13) rotatably mounted relative to the base member to pull and release a transmission control element (Column 5, lines 49-56), wherein the transmission control member (13) rotates around a transmission control member axis that is substantially parallel to the operating member axis in response to rotation of the operating member (11, Column 4, lines 57-65); an intermediate member (23) that moves in a direction of an intermediate member axis in response to rotation of the operating member (11), wherein the intermediate member includes an intermediate member detent (35, Column 5, lines 11-20) for maintaining a rotational position of the operating member (11) and the transmission control member (13).

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Re claim 2 Tagawa discloses the operating member (11) axis is spaced apart from the transmission control member (13) axis (See Figure 4).

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Hanatani US 2002/0128112.

Re claim 1 Hanatani discloses a bicycle shift control device comprising a base member (14) for attachment to the bicycle, an operating member (20) rotatably supported relative to the base member for rotating in first and second directions around an operating member axis (Page 2, lines 32-33); a transmission control member (46) rotatably mounted relative to the base member to pull and release a transmission control element (60 ), wherein the transmission control member (46) rotates around a transmission control member axis that is substantially parallel to the operating member axis in response to rotation of the operating member (See figure 2); an intermediate member (44) that moves in a direction of an intermediate member axis in response to rotation of the operating member (20), wherein the intermediate member includes an

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intermediate member detent (140,146) for maintaining a rotational position of the operating member (20) and the transmission control member (46).

Re claim 2 Hanatani discloses the operating member (20) axis is spaced apart from the transmission control member (46) axis (See Figure 4).

Re claim 3 Hanatani discloses the operating member (20) axis is substantially coaxial with the intermediate member (44) axis (See Figure 4).

Re claim 4, Hanatani discloses the intermediate member (44) is substantially nonrotatable relative to the base member (14).

Re claim 5 Hanatani discloses the operating member (20) includes a gear portion (130) that meshes with a gear portion of the transmission control member:

Re claim 6 Hanatani discloses the operating member (20) includes an operating member detent (132) that engages the intermediate member detent (142) for maintaining the rotational position of the operating member and the transmission control member (Column 4, paragraph 56).

### ***Response to Arguments***

5. Applicant's arguments filed 8/10/2006 have been fully considered but they are not persuasive.

Applicant argues that claim 2 has a further limitation different from claim 1 regarding the recitations spaced apart and substantially parallel.

In response the 112-2<sup>nd</sup> § rejection for "substantially parallel" has been withdrawn.

Applicant argues that Tagawa neither discloses nor suggests an intermediate member that includes an intermediate detent for maintaining a rotational position of the operating member and the transmission control member.

In response Tagawa does indeed disclose an intermediate member that includes an intermediate member detent (140,146) for maintaining a rotational position of the operating member (20) and the transmission control member (46).

Applicant argues that the planet gear of Hanatani does not pull and release a transmission control element.

In response Hanatani does indeed disclose that the planet gear does pull and release a transmission control element (page 6, lines 4-13).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Windley III whose telephone number is 571-272-6460. The examiner can normally be reached on 8:30 AM to 5:30 PM Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William Windley III  
10/11/2006



RICHARD RIDLEY  
SUPERVISORY PATENT EXAMINER